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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,478	07/26/1999	J. WALLACE PARCE	100/02510	5568

21569 7590 05/19/2006

CALIPER LIFE SCIENCES, INC.  
605 FAIRCHILD DRIVE  
MOUNTAIN VIEW, CA 94043-2234

EXAMINER
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TSAI, CAROL S W

ART UNIT	PAPER NUMBER
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2857

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/361,478

Applicant(s)

PARCE ET AL.

Examiner

Carol S. Tsai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/17/06.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 14 and 15 is/are allowed.  
6) ☒ Claim(s) 1 and 3-11 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 17, 2006 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 3-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the body of the claim does not appear to support the preamble. The preamble says it is a computer implemented method of "controlling an analytical instrument that analyzes microfluidic device...", but the list is never generated.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1 and 3-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In claim 1, the body of the claim does not appear to support the preamble. The preamble says it is a computer implemented method of “controlling an analytical instrument that analyzes microfluidic device ...”, but the list is never generated. This leads to a problem under 101, in that the method does not produce a tangible result..

**NOTE: If step of “scanning fluid as it passes a detection zone in the microfluidic device” can be amended to step of “scanning fluid as it passes a detection zone in the microfluidic device in order to analyze the fluids in the microfluidic device” that would be a tangible result and would support the preamble, resolving the 112, 2<sup>nd</sup> issue and 101 issue.**

*Allowable Subject Matter*

6. Claims 14 and 15 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter:

U. S. Publication 2004/0063162 to Dunlay et al. in view of U. S. Patent No. 6,500,323 to Chow et al. are references closest to the claimed invention. Dunlay et al. in combination with Chow et al. disclose a system, comprising: an instrument that controls and analyzes a microfluidic device; a computer including a processor and a computer readable medium, the computer being capable of directing the instrument to apply a driving force to fluid in wells of the microfluidic device; and code stored on the computer readable medium that includes a sequence of steps, each step specifying at least one well of a microfluidic device, a value

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indicative of the driving force to be applied to fluid in the at least one well in order to drive the fluid along a channel in the microfluidic device and a duration for applying the driving force specified by the value to the fluid in the at least one well. However, the rejection is overcome because the present application and U. S. Patent No. 6,500,323 to Chow et al. filed before November 29, 1999 were, at the time the invention of the present application was made, owned by the present Assignee, Caliper Technologies Corp. of Mountain View, California. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

#### *Contact Information*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol S. W. Tsai whose telephone number is (571) 272-2224. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571) 272-2216. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

cswt

May 12, 2006

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**CAROL S.W. TSAI**  
**PRIMARY EXAMINER**